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REMARKS

In an Office Action mailed on December 6, 2006, claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of Official Notice; claims 42, 44, 45, 53 and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of the EMCORE; claim 43 was rejected under 35 U.S.C. § 103(a) as being unpatentable over House and EMCORE and further in view of Joseph; claims 46, 47, 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House and EMCORE and further in view of the Official Notice; claims 50, 52 and 55 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House and EMCORE and further in view of the Official Notice; claim 51 was rejected under 35 U.S.C. § 103(a) as being unpatentable over House, EMCORE, Official Notice and further in view of the Hunter; claims 56, 57, 58 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over House in view of EMCORE; and claim 61 was rejected under 35 U.S.C. § 103(a) as being unpatentable over House and EMCORE and further in view of the Joseph and Official Notice.

The Examiner states that the § 112, first paragraph rejections are withdrawn subject to the claim language being limited to the following:

... to an unavailable product or attribute that is not offered for sale immediately, but which will be made available for sale upon sufficient indication of demand, and a program to manufacture the (currently) unavailable product or attribute.

Office Action, 12. Thus, the Examiner concedes that the specification contains a written description of at least one embodiment of the claimed online catalog and selector. Applicant maintains, however, that other embodiments of the invention are within the ordinary and customary meaning of the claim scope that is set forth in the claims. As this is the scope to which the Applicant is entitled, Applicant desires to maintain the breadth of the claim language, without unnecessarily limiting the language to the Examiner's construction or a specific embodiment described in the specification. Therefore, the Examiner is respectfully requested to reconsider the § 112, first paragraph rejections in view of the customary and ordinary meaning of the claim terms.

Regarding the § 103 rejections, the Examiner concedes that neither EMCORE nor House discloses via an unavailable product/attribute selector, using selections of unavailable products as

market research. Office Action, 3 and 13. Thus, a *prima facie* case of obviousness has not been established for any of the claims for at least the reason that the hypothetical combination of House and EMCORE fails to teach or suggest all claim limitations. More specifically, the Examiner appears to rely on House for the general teaching of a product selector and rely on EMCORE for the teaching of expanding a product line based on market research. However, neither reference, alone or in combination, teaches or suggests expanding a product line based on selection of an unavailable product by a product/attribute selector. Without the disclosure of the missing elements, a *prima facie* case of obviousness has not been established for any of the claims.

The Examiner refers to *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) for the purported authority for relying on the general level of skill in the art to establish a *prima facie* case of obviousness. However, in *In re Fine*, the Federal Circuit held that the Examiner had *failed* to establish a *prima facie* case of obviousness for the reason that the Examiner failed to show where the prior art taught or suggested all claim limitations. Rarely, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). Thus, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have derived the claimed invention in view of the EMCORE reference and House. Objective evidence is required, as mere speculation by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Therefore, for at least the following reasons, reconsideration of the § 103 rejections of claims 42-55 is respectfully requested.

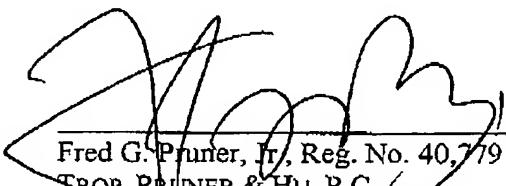
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CONCLUSION

In view of the foregoing, Applicant respectfully requests withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (SHL.0293US).

Respectfully submitted,



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